

I. Response to Obviousness-Type Double Patenting Rejection

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3 and 14 of co-pending Application No. 10/806,424.

Applicants respectfully traverse the rejection. Applicants submit that the recitation of a phthalocyanine dye having -SO, -SO₂-, -CO- and/or -CO₂- groups in the claims of the '424 application does not fairly teach or suggest the specific dye recited in present claim 1. Further, Applicants note that the Examiner refers to the disclosure of the specification at sections [0069]-[0082] in support of her position that the ink containing a phthalocyanine dye recited in claims 1, 3 and 14 of the '424 application broadly encompasses the presently claimed inkjet recording ink. However, it is improper for the Examiner to rely on the disclosure of the specification of the '424 application. The proper inquiry for an obviousness-type double patenting rejection is whether the claimed subject matter of the present application is an obvious variation of an invention claimed in another commonly owned application, based upon what is recited in the claim(s) of the reference and not what is disclosed in the specification. *See* MPEP 804(II)(B)(1). In this regard, Applicants submit that one of ordinary skill in the art would not have been reasonably motivated to select the specific dye recited in present claim 1 based upon what is recited in claims 1, 3 and 14 of the '424 application.

Even further, the claims of the '424 application were amended in an Amendment filed on August 18, 2005 and the '424 application has been allowed. The presently claimed invention is not an obvious variant of the allowed claims of the '424 application.

Accordingly, Applicants respectfully request withdrawal of the obviousness-type double patenting rejection.

II. Response to Claim Rejection – 35 U.S.C. § 103

Claims 1-8 are rejected under 35 U.S.C. § 103 over Kenworthy as applied in the Office Action dated March 28, 2005.

Applicants respectfully traverse the rejection and submit that the Examiner has not made a *prima facie* showing of obviousness.

The present invention is directed to an inkjet recording ink comprising an aqueous medium having dissolved therein a dye represented by the formula (I), which is water-soluble and contains a lithium ion as a counter ion, wherein the total amount of a cation in said ink except for a lithium ion, a hydrogen ion, an ammonium ion, an organic quaternary nitrogen ion and an ion produced by proton addition to a nitrogen atom in a basic organic material is 0.5 wt% or less.

In stating that it would have been obvious for one of ordinary skill in the art to use the specific phthalocyanine dye containing a lithium ion because Kenworthy discloses the use of phthalocyanine dyes, the Examiner is saying, in effect, that it is obvious to try various phthalocyanine compounds to determine optimum conditions. However, the applicable law is to the contrary. The law states that it is not a valid basis for rejecting a claim under 35 U.S.C. § 103(a) that it was obvious to try variations to find an optimum or workable range. *See, e.g., In re Sigco*, 36 USPQ2d 1380, 1382 (Fed. Cir. 1995) (citing *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1521, 1532 (Fed. Cir. 1988) (rejecting the "obvious to try" standard)); *In re*

Deuel, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995) (“obvious to try” has long been held not to constitute obviousness”).

Further, the Examiner’s statement that the element of the total amount of cations is obvious “because there does not appear to be any reason why the cited reference would not contain an ink composition with applicants claimed amount of cations” is not a sufficient basis for establishing obviousness. It has been established that the prior art must suggest the desirability to modify or combine disclosures. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The fact that there is no specific teaching away from the claimed invention is not sufficient to establish *prima facie* obviousness.

Although Kenworthy discloses a phthalocyanine dye having an SO₃H group, which may be in the form of a salt, there is no disclosure about a water-soluble dye of formula (I) of the present invention containing a specific counter ion (i.e., a lithium ion). Further, Kenworthy does not disclose that the total amount of cations except for specific ions in the ink composition is 0.5 wt% or less.

The ink composition of the present invention can achieve excellent advantages, such as the effect of improving bronze luster, by including a water-soluble dye containing a lithium ion as a counter cation and by making the total amount of cations except for specific ions 0.5 wt% or less. The working example of the specification demonstrates the effect of improving bronze luster of the present invention (see Ink Nos. 101 and 102). Kenworthy does not disclose, suggest or even recognize such excellent advantages.

Although Kenworthy discloses that the dyes are converted to their purified ammonium salts by filtration and desalination, the conditions for the filtration and desalination are not

clearly disclosed. Accordingly, since it is not possible to demonstrate the filtration or desalination of Kenworthy, it is not apparent whether or not the total amount of cations in the ink composition of Kenworthy is 5 wt% or less. Thus, the claimed invention is not enabled by Kenworthy. Therefore, one of ordinary skill in the art would not have been motivated to modify Kenworthy with a reasonable expectation of success in achieving the claimed invention.

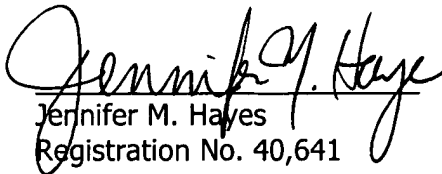
In view of the above, the presently claimed invention is not rendered obvious by the prior art. Accordingly, Applicants respectfully request withdrawal of the rejection.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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